

**REMARKS**

The Office Action dated November 17, 2003 has been carefully reviewed and the following response has been made in consequence thereof.

Claims 1-20 are now pending in this application. Claims 1-20 stand rejected.

The undersigned wishes to express his appreciation to the Examiner for the courtesies that he extended during a telephone interview that occurred on April 8, 2004. The Examiner discussed the rationale supporting the 103 rejection. Although agreement was not reached on specific amendments to the claims, the Examiner and the undersigned both agreed that an argument may be made that the cited art does not disclose nor suggest the head of a fastener being exposed to any rotating components, such as a motor.

In accordance with 37 C.F.R. 1.136(a), a two month extension of time is submitted herewith to extend the due date of the response to the Office Action dated November 17, 2003, for the above-identified patent application from February 17, 2004, through and including April 19, 2004. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$420.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-4 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over Fisher et al. (U.S. Patent No. 6,005,314) ("Fisher") in view of Admitted Prior Art ("APA") of Figure 1 in view of Story et al. (U.S. Patent No. 3,787,014) ("Story") and in further view of Boede et al. (U.S. Patent No. 4,933,809) ("Boede") is respectfully traversed.

Fisher describes a motor (50) that includes a housing (54) formed by a motor shell (56) and a pair of endshields (58 and 60). A stator (72) is mounted within the motor shell. The motor also includes a base (92) for support and mounting. Notably, Fisher does not describe nor suggest a method for mounting a motor to a support that includes attaching a plurality of fasteners to an inner surface of a plurality of recessed openings such that the fasteners extend radially outwardly through the housing and a head of the fasteners is

substantially co-planar with an un-recessed portion of the inner surface of the housing. Additionally, Fisher does not describe nor suggest that the head of the fasteners is potentially exposed to a rotating component such as a motor.

APA describes a motor housing (10) that includes a shell (12) having an inner surface (14) and an outer surface (16). A plurality of mounting hardware or fasteners (20) are attached to the shell outer surface and extend radially outwardly from the shell outer surface. Fasteners (20) are spaced circumferentially around the housing and may be welded to shell outer surface (16). Notably, APA does not describe nor suggest a method for mounting a motor to a support that includes attaching a plurality of fasteners to an inner surface of a plurality of recessed openings such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed portion of the inner surface of the housing. Additionally, APA does not describe nor suggest that the head of the fasteners is potentially exposed to a rotating component such as a motor.

Story describes a replacement motor mounting (50) that includes an adapter bracket (58) that includes a circular central portion and four arms. A set of fastener receiving holes (62, 64) is formed in the arms and is configured to receive a plurality of fasteners (66) extending axially from an endshield. Notably, Story does not describe nor suggest a method for mounting a motor to a support that includes attaching a plurality of fasteners to an inner surface of a plurality of recessed openings such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed portion of the inner surface of the housing. Additionally, Story does not describe nor suggest that the head of the fasteners is potentially exposed to a rotating component such as a motor.

Boede describes a modular assembly of diverse electrical components housed in a box (10). The box is closed with a cover (47) that includes a plurality of mounting holes (56) positioned in recesses (58) and configured to receive a plurality of mounting screws (52). Notably, Boede does not describe nor suggest a method for mounting a motor to a support that includes attaching a plurality of fasteners to an inner surface of a plurality of recessed openings such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed portion of the inner surface of the

housing. Additionally, the screws cannot be reversed because the cover recesses are configured to mate with specific bosses on the interior of the box. Rather, Boede describes fasteners that are configured to attach to an outer surface of an electrical component box cover and extend inwardly through the cover, which would render the present invention inoperable. Furthermore, Boede does not describe nor suggest that the head of the fasteners is potentially exposed to a rotating component such as a motor.

Claim 1 recites “a method for mounting a motor to a support using a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing including a plurality of recessed openings, an outer surface, and an inner surface, said method comprising...attaching the fasteners through the openings in the recesses formed in the housing such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed inner surface of the housing and such that the head of the fasteners remain positioned between rotating components of the motor and the housing outer surface...and attaching the motor to the support using the plurality of fasteners.”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a method for mounting a motor to a support using a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing including a plurality of recessed openings, an outer surface, and an inner surface, the method including attaching the fasteners through the openings in the recesses formed in the housing such that the fasteners extend radially outwardly through the housing and a head of the fasteners is substantially co-planar with an un-recessed inner surface of the housing and such that the head of the fasteners remain positioned between rotating components of the motor and the housing outer surface, and attaching the motor to the support using the plurality of fasteners. Furthermore, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a mounting system that includes fasteners that extend through a housing such that the fastener heads remain potentially exposed to a rotating component such as a motor.

Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to an outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 2-4 depend from independent Claim 1. When the recitations of Claims 2-4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-4 likewise are patentable over Fisher in view of APA, Story and Boede.

Claim 14 recites “a motor comprising a pair of endshields...a housing extending between said endshields including at least one raised projection extending outwardly from said housing, said housing comprising an outer surface and an opposite inner surface, said projection defining a recess with respect to said inner surface, at least one opening extending through said recess, and at least one fastener having a top surface, said at least one fastener extends outwardly through said housing such that said top surface is substantially co-planar with said inner surface...and a stator-rotor assembly mounted in said housing, such that said housing inner surface extends between said stator-rotor assembly and said housing outer surface.”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motor including a pair of endshields, a housing extending between the endshields including at least one raised projection extending outwardly from the housing, the housing including an outer surface and an opposite inner surface, the projection defining a recess with respect to the inner surface, at least one opening extending through the recess, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing such that the top surface is substantially co-planar with the inner surface, and a

stator-rotor assembly mounted in the housing, such that said housing inner surface extends between said stator-rotor assembly and said housing outer surface. Furthermore, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a mounting system that includes fasteners that extend through a housing such that the fastener heads remain potentially exposed to a rotating component such as a motor.

Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to an outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 14 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 15-20 depend, directly or indirectly, from independent Claim 14. When the recitations of Claims 15-20 are considered in combination with the recitations of Claim 14, Applicants submit that dependent Claims 15-20 likewise are patentable over Fisher in view of APA, Story and Boede.

Furthermore, Applicants respectfully submit that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed

invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such inferences, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991).

In the present case, neither a suggestion nor motivation to modify the cited art, nor any reasonable expectation of success has been shown. Specifically, no teaching, or suggestion has been shown to modify Fisher, APA, Story with Boede to include fasteners that extend through a housing such that the fastener heads remain potentially exposed to a rotating component such as a motor. Rather, the Section 103 rejection appears to be based on a hindsight reconstruction in which several disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-4 and 14-20 be withdrawn.

Furthermore, Applicants respectfully submit that Boede teaches away from the present invention. If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Boede describes fasteners that are configured to attach to an outer surface of an electrical component box cover and extend inwardly through the cover, which would render the present invention inoperable and eliminate any reasonable expectation of success.

Additionally, Applicants respectfully disagree with the Examiner's statement that "the fastener it self is considered to be 'configured' to attach to an inner surface...since the fastener includes a mounting head which permits the fastener to be attached to an inner or outer surface of a housing." Rather, Applicants respectfully note, that attaching the fastener to "an inner *or* outer surface" would render the cited art inoperable. Specifically, the mounting screws (52) cannot be reversed because the cover recesses (58) are formed in the outer surface of the cover (47), not the "underside which bears on the top of an interior cover mounting boss (28)." (Col. 4, lines 51-52). Accordingly, Applicants respectfully submit that Boede teaches away from the present invention, and as such, Applicants request that the Section 103 rejection of Claims 1-4 and 14-20 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 1-4 and 14-20 be withdrawn.

The rejection of Claims 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art ("APA") of Figure 1 in view of Story and in further view of Boede is respectfully traversed.

APA, Story, and Boede are described above.

Claim 5 recites "a housing for a motor extending between a pair of endshields, said housing comprising...an inner surface...an outer surface, said inner surface extending between a rotating component of the motor and said outer surface...at least one raised projection extending outwardly from at least one of said housing inner surface and said housing outer surface defining a recess with respect to said housing inner surface, said projection comprising at least one opening extending therethrough...and at least one fastener having a top surface, said at least one fastener extends outwardly through said housing opening such that said top surface is substantially co-planar with an un-recessed portion of said housing inner surface."

None of APA, Story, or Boede, considered alone or in combination, describe or suggest a housing for a motor extending between a pair of endshields, the housing including

an inner surface, an outer surface, the inner surface extending between a rotating component of the motor and the outer surface, at least one raised projection extending outwardly from at least one of the housing inner surface and the housing outer surface defining a recess with respect to the housing inner surface, the projection including at least one opening extending therethrough, and at least one fastener having a top surface, the at least one fastener extends outwardly through the housing opening such that the top surface is substantially co-planar with an un-recessed portion of the housing inner surface. Furthermore, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a mounting system that includes fasteners that extend through a housing such that the fastener heads remain potentially exposed to a rotating component such as a motor.

Rather, APA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to the outer surface of the box and extend inwardly through the box. For at least the reasons set forth above, Claim 5 is submitted to be patentable over APA in view of Story and Boede.

Claims 6-13 depend from independent Claim 5. When the recitations of Claims 6-13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-13 likewise are patentable over APA in view of Story and Boede.

Furthermore, Applicants respectfully submit that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.



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[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

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In the present case, neither a suggestion nor motivation to modify the cited art, nor any reasonable expectation of success has been shown. Specifically, no teaching, or suggestion has been shown to modify APA and Story with Boede to include fasteners that extend through a housing such that the fastener heads remain potentially exposed to a rotating component such as a motor. Rather, the Section 103 rejection appears to be based on a hindsight reconstruction in which several disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 15-13 be withdrawn.

Furthermore, Applicants respectfully submit that Boede teaches away from the present invention. If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Boede describes fasteners that are configured to attach to an outer surface of an electrical component box cover and extend inwardly through the cover,

which would render the present invention inoperable and eliminate any reasonable expectation of success.

Additionally, Applicants respectfully disagree with the Examiner's statement that "the fastener it self is considered to be 'configured' to attach to an inner surface...since the fastener includes a mounting head which permits the fastener to be attached to an inner or outer surface of a housing." Rather, Applicants respectfully note, that attaching the fastener to "an inner *or* outer surface" would render the cited art inoperable. Specifically, the mounting screws (52) cannot be reversed because the cover recesses (58) are formed in the outer surface of the cover (47), not the "underside which bears on the top of an interior cover mounting boss (28)." (Col. 4, lines 51-52). Accordingly, Applicants respectfully submit that Boede teaches away from the present invention, and as such, Applicants request that the Section 103 rejection of Claims 5-13 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 5-13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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